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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/784,645 | 02/23/2004 | Joseph P. Errico | SPINE 3.0-437 CPCPCPCPCPC | 8190 |
| 51640 | 7590 | 10/16/2009 | EXAMINER | |
| SPINE MP LERNER, DAVID, et al. 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090 | | | PELLEGRINO, BRIAN E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3738 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 10/16/2009 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|--------------------------------------|--|
| Office Action Summary | Application No. 10/784,645 | Applicant(s) ERRICO ET AL. | |
| | Examiner Brian E. Pellegrino | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/28/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/09 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 14-16,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucherman et al. (6712819) in view of Shearer et al. (2004/59343) and Grunberg et al. (WO 02/071986). Zucherman et al. show (Fig. 2) apparatus for manipulating an orthopedic device having a shaft **20** with an extension **30** including a confronting surface **145** substantially perpendicular to the shaft longitudinal axis. It can also be seen there is a holding pin **157** bent downward and coupled with rod **40** such that it is located internal to the shaft. There is also a spring **125** coupled to the rod of the pin and configured to bias the distal end of the pin inward and outward. Additionally, Zucherman discloses a flange **112** mechanically coupled to the rod of the pin that when pressure is exerted on

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the flange distally, it overcomes the spring-load of the spring to space the pin from the extension. Zucherman also discloses the surface of the extension prevents the pin from being entirely retracted therein, col. 6, lines 29-31. However, Zucherman et al. fail to disclose locating at least a portion of the spring internal to the shaft. Shearer et al. teach (Figs. 29-31) a shaft **28** having a spring **82** internally located to controllably deliver a prosthesis. The spring enables manipulation or control of rod **12** or elongate pin coupled to the spring. It would have been obvious to one of ordinary skill in the art to modify the spring location to be internal the shaft as taught by Shearer et al. with the prosthesis inserter of Zucherman et al. such that it provides more control with manipulation or placement of the prosthesis in the patient. Regarding claims 15,16 Zucherman discloses (Figs. 8b,8c) plates **800** with baseplate holes **806** for receiving pins of the tool. Additionally, Zucherman does not disclose the pin being bent down such that its engaging end is perpendicular to the axis of the shaft. Grunberg et al. teach (Fig. 4c) that a tool for delivering an implant to the spine has a retractable rod with a pin at the distal end that is perpendicular to the shaft. Grunberg et al. teach that the pin is designed to engage holes or recesses that are perpendicular to the axis of the shaft of the tool, Page 18. Grunberg also illustrates (Fig. 8) the engagement of such a pin in a recess of a baseplate. It would have been obvious to one of ordinary skill in the art to modify the pin of the tool of Zucherman as modified with Shearer and to place it in a perpendicular orientation or bent downward such that it matches or engages the hole or recess of baseplate for spinal surgery as taught by Grunberg et al.

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With respect to claims 19, 20, it is noted that Zucherman discloses a knob coupled to the shaft that is rotatable and is threaded thereto, Figs. 5, 6. Shearer also teach a rotatable knob for use of the delivery tool. Grunberg additionally teaches (Fig. 4a) that a knob (414) for rotation of a shaft to move the distal end.

Response to Arguments

Applicant's arguments with respect to claim 14 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M- F (7am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700
/Brian E Pellegrino/
Primary Examiner, Art Unit 3738